



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/079,819	05/15/1998	VERNON L. ALVAREZ	1101209	8754

7590 08/05/2002

PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

TELLER, ROY R

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 08/05/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/079,819

Applicant(s)

ALVAREZ ET AL.

Examiner

Roy Teller

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 165-239 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 165-239 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

In view of the letter withdrawing the application from issue dated May 30, 2002 the finality of the prior office action is removed. An amendment filed 1/7/02 (paper #20) has amended claims 166, 182, 198, 211 and 226. All claims are subject to the below requirements for restriction.

Election/Restrictions

In view of the foregoing, restriction to one of the following inventions is required under 35 U.S.C. 121 to elect one receptor and one binding partner polypeptide by sequence identification number.

1) One patentably distinct and independent receptor from among SEQ ID NO: 178, 176, 179, and 181, class 530, subclass 350.

2) One distinct binding partner peptide selected from sequences of SEQ ID NO: 1-55 and SEQ ID NO: 253-265, class 530, subclass 300.

The receptor sequences recited in the claims are also distinct and different proteins on the basis of physical, chemical, and biological properties even where the application would place all as gastrointestinal tract receptors, they are all of different structure and function. For example, where HPTI (SEQ ID NO: 178) is a receptor (as recited in the claim), D2H (SEQ ID NO: 179)

Art Unit: 1653

would appear to be an enzyme sucrase isomaltase (specification, page 11, Figure 3A-3B). The other two recited sequences are not receptors but transporters (specification, page 11). Thus, each Of the recited receptor sequences in the claim are distinct and/or independent as to physical, chemical, and biological properties and functions.

The peptide sequences recited in the claims are distinct and different peptides on the basis of physical, chemical, and biological properties. For example, table 23, page 105, shows several peptides with differences in pI of almost 2 pI units. Other tables in the application also appear to show that the peptides defined by sequence have different chemical and physical properties. Thus, each of the recited peptide sequences in the claim are distinct and/or independent as to physical, chemical, and biological properties and functions.

The search of the patent and technical literature for one of the receptors and its binding partner would not have resulted in a complete search for any one of the receptor/ binding peptide combination.

Because these inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their different classification and/or divergent subject matter, and/or are separately and independently searched, restriction for examination purposes as indicated is proper.

Art Unit: 1653

Applicant is free to elect one item of item 1 and one item of item 2 above to which the claims shall be restricted. Applicant may provide additional claims which will be given appropriate consideration.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143) and a list of claims readable thereon. All prior office actions are vacated and patentability of the elected invention will be reassessed based on applicant's election. Applicant may also present appropriate amended claims.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently- filed petition under 37 C.F.R. 1.48 (b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is (703)305-4243. The examiner can normally be reached on Monday-Friday from 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4242.

Art Unit: 1653

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

RT
1653

RT


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800